

## **Remarks**

According to the Advisory Action mailed January 9, 2008, Applicants understand that the Amendment filed December 27, 2007 will be entered.

Claims 1-3 and 5-20 were pending in the application, and stand rejected. By this paper, claims 1 and 13 have been amended, and reconsideration of the claims is respectfully requested. Furthermore, claims 3 and 6 have been canceled, and new claims 21-23 have been added.

### **Rejections Under 35 U.S.C. § 102 and 103**

In the final Office Action mailed October 4, 2007, claims 1-6, 8 and 9 were rejected under § 102(b) as being anticipated by U.S. Patent No. 5,679,938 to Templeton et al. ("Templeton"); claim 7 was rejected under § 103(a) as being unpatentable over Templeton; and claims 10-20 were rejected under § 103(a) as being unpatentable over Templeton in view of U.S. Patent No. 5,897,625 to Gustin et al. ("Gustin"). By the Amendment filed December 27, 2007, claim 1 was amended to recite automatically printing a mark on a document using a printer in communication with the terminal, wherein the mark corresponds with the sign so as to indicate the authorization status of the negotiable instrument, "and wherein the mark indicates that the negotiable instrument is not authorized for encashment." Similarly, claim 13 was amended to recite a printing device in communication with the terminal that automatically prints a mark on a document, wherein the mark corresponds with the sign so as to indicate the authorization status of the negotiable instrument, "and wherein the mark indicates that the negotiable instrument is not authorized for encashment."

In the Advisory Action mailed January 9, 2008, the Examiner indicated that the amendments to claims 1 and 13 "introduce the specific data content of the mark," and acknowledged that "Templeton does not teach such data contents." However, the Examiner also argued that "these differences are only found in the non-functional descriptive material and are

not functionally involved in the method (or structurally programmed) steps recited." The Examiner further argued that the "steps would be performed the same regardless of data contents."

Applicants respectfully disagree with the Examiner's position. In that regard, the recitation in both claims 1 and 13 that the mark "indicates that the negotiable instrument is not authorized for encashment" is functionally involved in the method steps recited in claim 1 and the system recited in claim 13. More specifically, that recitation clarifies what is printed on the document during the "automatically printing" step of claim 1 and also clarifies what the printing device of claim 13 prints on the document depending on the authorization status of the negotiable instrument.

By this paper, however, claims 1 and 13 have been amended to further clarify the claimed invention. More specifically, claim 1 has been amended to recite "upon an indication that the negotiable instrument is not authorized for encashment, automatically printing a mark on a document, wherein the mark corresponds with the sign and indicates that the negotiable instrument is not authorized for encashment." Similarly, claim 13 has been amended to recite a printing device in communication with the terminal that automatically prints a mark on a document "upon an indication that the negotiable instrument is not authorized for encashment, wherein the mark corresponds with the sign and indicates that the negotiable instrument is not authorized for encashment." Because the above features of either claim 1 or claim 13 are not disclosed in the cited references, taken alone or in combination, claims 1 and 13, as well as the associated dependent claims, are believed to be allowable.

Regarding claim 12, that claim recites "automatically printing processing instructions on the negotiable instrument if the sign indicates that the negotiable instrument is not authorized for encashment." As indicated in the prior Amendment filed December 27, 2007, a non-limiting example of such processing instructions includes automatically printing "**POSSIBLE COUNTERFEIT INSTRUMENT, CALL CUSTOMER SERVICE**" (see, page 7 of the Application). Because the above features of claim 12 are not disclosed in the cited references, taken alone or in combination, the § 103(a) rejection of claim 12 is believed to be

improper and should be withdrawn. Furthermore, these features are not even addressed in the prior Office Action or Advisory Action.

Likewise, claim 20 recites a system including a host computer that is “operative to issue processing instructions to the terminal if the negotiable instrument is not authorized for encashment,” and a printing device that is “operative to automatically print the processing instructions on the negotiable instrument if the negotiable instrument is not authorized for encashment.” Because these features are not disclosed in the cited references, taken alone or in combination, the § 103(a) rejection of claim 20 is believed to be improper and should be withdrawn. Furthermore, these features are not even addressed in the prior Office Action or Advisory Action.

### **New Claims**

New claims 21-23 have been added for consideration by the Examiner. Because claims 21-23 depend from claim 1, which is believed to be allowable as discussed above, claims 21-23 are also believed to be allowable.

### **Conclusion**

Applicants have made a genuine effort to respond to each of the Examiner’s objections and rejections in advancing the prosecution of this case. Applicants believe that all formal and substantive requirements for patentability have been met and that this case is in condition for allowance, which action is respectfully requested. If any additional issues need to be resolved, the Examiner is invited to contact the undersigned at his earliest convenience.

Please charge the Petition Fee for filing a one-month extension of time and any other required fees as a result of the filing of this paper to our Deposit Account No. 02-3978.

Respectfully submitted,  
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